

REMARKS:

Applicant has carefully studied the nonfinal Examiner's Action and all references cited therein. The amendment appearing above and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Applicant responds to the outstanding Action by centered headings that correspond to the centered headings employed by the Office, to ensure full response on the merits to each finding of the Office.

Claim Rejection – 35 U.S.C. 112

The Office has rejected claim 4, citing insufficient antecedent basis for the limitation, "outer electrode", in line 2 of the claim.

Claim 4 has been amended to overcome the rejection by the Office. Claim 4 is now believed to be in condition for allowance.

Claim Objections

Claims 10 and 11 stand rejected due to the following informalities: claim 11 is dependent upon itself and claim 10 is dependent upon claim 11 which is dependent upon itself.

Claims 1 and 12 stand objected to due to the following informalities: The term "discrete electrodes" is found to be a broad and vague terms. The Office has requested that the applicant clarify the term. The Office has noted that in a previous application 09/696350 in an office action mailed 1/21/04 a request for clarification was made in which a claim amendment was requested for the circuit communication to be deemed an "independent circuit communication". Appropriate correction is required by the Office.

Claim 2 stands objected to due to the following informalities: The term "higher" is deemed to be broad and vague and can be defined in multiple ways. The Office has requested clarification by the Applicant for the term "higher".

Claims 2, 10, 11 and 12 have been amended to overcome the objections by the Office. As such, claims 2, 10, 11 and 12 are now believed to be in condition for allowance.

Claim Rejection 35 U.S.C. 102(b)

Claims 1-4, 8 and 12 stand rejected under 35 U.S.C. 102(b) as being anticipated by Weaver (U.S. Patent No. 5,389,069). The Office states that the Weaver reference discloses a device for manipulating a molecule in vivo relative to a target tissue, with reference to Fig. 5, comprising an elongated member 148 comprising a generally cylindrical nonconductive core post and at least two discrete electrodes (152, 154); the at least two discrete electrodes being circumferential rings disposed about the core and in axially spaced relation along the elongated member, each electrode being in circuit communication with a respective portion of a source of electrical energy, the discrete electrodes being configured to establish a first electromagnetic field in vivo between selected electrodes sufficient to cause an electromigration of a molecule relative to a target tissue and a second electromagnetic field sufficient to cause a transient permeability of a cell membrane within the target tissue; and an insulating material (seen as the material between the two electrodes) interposed axially between the electrodes for achieving relative electromagnetic isolation of the electrodes, referring to col. 2, lines 8-60 and col. 8, line 5-21 of Weaver.

Independent claims 1 and 12 have been amended to more clearly describe that which the applicant regards as the invention. Claims 1 and 12, as amended, describe a device for manipulating a molecule in vivo relative to a target tissue comprising an elongated member comprising a generally cylindrical nonconductive core post and at least three discrete electrodes being circumferential rings disposed about the core in an axially spaced relation along the elongated member. As illustrated in Fig. 5 of the specification as filed, a nonconductive core

post 28 is shown having five discrete electrodes 23-27. Applicant believes that amended claims 1 and 12 are not anticipated by Weaver and are believed to be in condition for allowance.

Claims 2-11 are dependent upon claim 1, which has been shown to be allowable, and are therefore allowable as a matter of law.

Claim Rejection 35 U.S.C. 103(a)

Claims 1-4, 8 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tu et al. (U.S. Patent No. 5,941,845) and further in view of Goble et al. (U.S. Patent No. 5,944,715). The Office states that the Tu reference discloses a device for manipulating a molecule in vivo relative to a target tissue comprising an elongated member comprising a generally cylindrical nonconductive core post and at least two discrete electrodes; the at least two discrete electrodes being circumferential rings disposed about the core and in axially spaced relation along the elongated member, each electrode being in circuit communication with a respective portion of a source of electrical energy, the discrete electrodes being configured to establish a first electromagnetic field in vivo between selected electrodes sufficient to cause an electromigration of a molecule relative to a target tissue and a second electromagnetic field sufficient to cause a transient permeability of a cell membrane within the target tissue. The Office states that even though Tu does not explicitly disclose an insulating material interposed axially between the electrodes, attention is directed to Goble whereby the Goble reference teaches the use of an insulated material between the electrodes at col. 3, line 64 – col. 4, line 30, col. 6, line 28 – col. 7, line 4 and the abstract. The Office has concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Tue with the teachings of Goble in order to provide finely defined paths and insulate between the two electrodes.

Independent claims 1 and 12 have been amended to more clearly describe that which the applicant regards as the invention. Claims 1 and 12, as amended, describe a device for manipulating a molecule in vivo relative to a target tissue comprising an elongated member comprising a generally cylindrical nonconductive core post and at least three discrete electrodes

being circumferential rings disposed about the core in an axially spaced relation along the elongated member. As illustrated in Fig. 5 of the specification as filed, a nonconductive core post 28 is shown having five discrete electrodes 23-27. Applicant believes that amended claims 1 and 12 are patentable over Tu in view of Goble and are believed to be in condition for allowance.

Claims 2-11 are dependent upon claim 1, which has been shown to be allowable, and are therefore allowable as a matter of law.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (813) 925-8505 is requested.

Very respectfully,
SMITH & HOPEN



By: _____

Dated: December 18, 2006

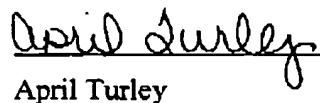
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CERTIFICATE OF FACSIMILE TRANSMISSION

(37 C.F.R. 1.10)

HEREBY CERTIFY that this Amendment A along with amendments to the claims and remarks is being transmitted by facsimile to the United States Patent and Trademark Office, Art Unit 3767, Attn: Benjamin Huh, (571) 273-8300 on December 18, 2006.

Dated: December 18, 2006


April Turley